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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/765,391	01/28/2004	Anthony Di Bitonto	B0224.0079	2535
32172	7590	06/24/2005	EXAMINER	
DICKSTEIN SHAPIRO MORIN & OSHINSKY LLP 1177 AVENUE OF THE AMERICAS (6TH AVENUE) 41 ST FL. NEW YORK, NY 10036-2714			NGUYEN, PHONG H	
			ART UNIT	PAPER NUMBER
			3724	

DATE MAILED: 06/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/765,391	DI BITONTO ET AL.
	<b>Examiner</b>	<b>Art Unit</b>
	Phong H. Nguyen	3724

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM  
 THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 06 April 2005.  
 2a) This action is FINAL.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-15 is/are pending in the application.  
 4a) Of the above claim(s) 2-4 and 9-15 is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1 and 5-8 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on 28 January 2004 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
 Paper No(s)/Mail Date 08/13/2004.
- 4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date. \_\_\_\_\_.  
 5) Notice of Informal Patent Application (PTO-152)  
 6) Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election with traverse of claims 1-10, 12 and 13 in the reply filed on 04/06/2005 is acknowledged. The traversal is on the ground(s) that Species A and Species B are overlap and a device having a bumper on upper and lower members has a bumper on the lower member. This is not found persuasive because Species A and Species B are distinct. Searching for both of the species creates a serious burden on the Examiner. If the Applicant believes that Species A and Species B are obvious variants, Applicant should state so on the record. If it is the case and the Examiner finds one of the species unpatentable over prior art, the evidence or admission may be used in a rejection under 35 USC 103(a) of the other invention. Applicant is noted that the restriction is based on the ground of two different types of bumpers but not bumpers on the top and bottom members as Applicant argues.

Claims 2-4 and 9-13 are further withdrawn from consideration since they belong to non-elected species or depend on non-elected species.

The requirement is still deemed proper and is therefore made FINAL.

### ***Drawings***

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the following must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

- In claim 1 the interconnection between the top and bottom members and a post extending from the bottom member to the top member.
- In claim 6 a thumb accepting depression on the lever.
- In claim 8 the cutting edges are offset from the central longitudinal axis of the top and bottom members.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

*Specification*

3. The Specification is objected to under 37 CFR 1.71 because it does not clearly describe the structure of the clipper in Fig. 5 which Applicant claims as his invention. As shown in Fig. 5, the top and bottom members are not interconnected and there is no post extending from the top surface of the bottom member to the top surface of the top member as described in claim 1.

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

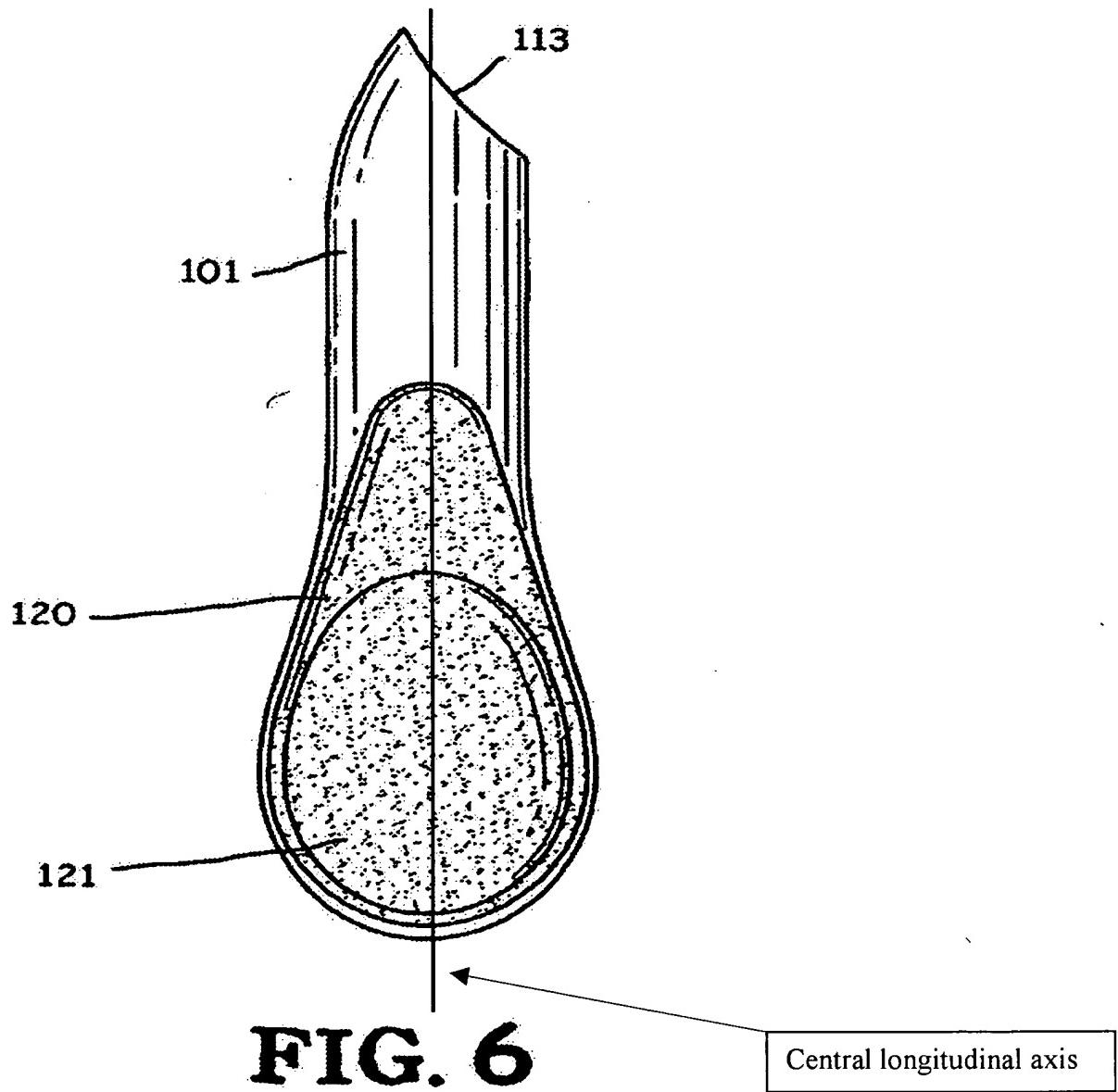
5. Claims 1 and 5-8 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Regarding claim 1, claim 1 states the distal ends of the top and bottom members being interconnected and a post extending from the top surface of the bottom member to the top surface of the top member. However, it appears in Fig. 5, which represents Species B, that the lower member 102 and the top member 101 are not connected together and there is no post extending from the top surface of the bottom member to the top surface of the top member. Without the post it is unclear what element guides the

upper member when it moves down to contact the lower member during the clipping process.

Regarding claim 6, claim 6 states the lever having a thumb accepting depression. However, it appears in Figs. 5 and 6 that the thumb accepting depression is on the top member 101. It is unclear when one clips his nails, does he applies force on the lever 118 or the top member 101 since in a conventional clipper one would apply force on the lever.

Regarding claim 8, claim 8 states the cutting edges 113 being offset from a central longitudinal axis of the top and bottom members. However in Fig. 6 the cutting edges are on the central longitudinal axis of the top and bottom members. It is unclear where the location of the cutting edges is.



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6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1 and 5-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is unclear whether the Applicant claims the triangle shaped bumpers being provided on the nail clipper in Fig. 4 or Fig. 5. There is no indication in the Specification that the triangle shaped bumpers can be used in the nail clipper in Fig. 4. The allowability cannot be commented on at this time in view of the issues under 37 CFR 1.71 and 35 USC 112. Moreover, the next Office Action is intended to be a Final Action if prior art is determined to be applicable upon compliance with under 37 CFR 1.71 and 35 USC 112.

### *Conclusion*

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Bazal (5,524,344), Fowler (5,640,770) and Cho (US Pub. 2004/0194795 A1) teach nail clippers of general interest.

Hodson (4,980,975), Khachatoorian (6,065,376) and Gruber (US Pub. 2004/0107806 A1) teach bumpers of general interest.

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9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Phong H. Nguyen whose telephone number is 571-272-4510. The examiner can normally be reached on Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allan Shoap can be reached on 571-272-4514. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

PN: *pn*

June 19, 2005

*ay*  
Allan N. Shoap  
Supervisory Patent Examiner  
Group 3700